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| Pearne & Gordon LLP 1801 East 9th Street Suite 1200 Cleveland, OH 44114-3108 | | | EXAMINER PURDY, KYLE A | |
| | | | ART UNIT 1611 | PAPER NUMBER |
| | | | NOTIFICATION DATE 07/21/2009 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/511,533

Applicant(s)

LAMERI, PAOLO

Examiner

Kyle Purdy

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/29/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9 and 12-35 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 and 28-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9,12,13,22,23,26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/29/2009 has been entered.

Status of Application

2. The Examiner acknowledges receipt of the amendments filed on 04/29/2009 wherein claims 8 and 33 have been amended.

3. Claims 8, 9, 12-32, 26-35 are pending, claims 8, 9, 12, 13, 22, 23, 26 and 27 are presented for examination on the merits and claims 14-21 and 28-35 stand as withdrawn. The following rejections are made.

Response to 132 Declaration

4. The declaration under 37 CFR 1.132 filed 04/29/2009 is insufficient to overcome the rejection of claims 8, 9, 22 and 23 based upon Bratescu et al. (US 6528070) in view of Narayanan et al. (US 5176736) and claims 12, 13, 26 and 27 based upon Bratescu in view of Narayanan further in view of Huber-Emden et al. (US 3873703) as set forth in the last Office action.

5. The submitted declaration attempts to show that an emulsion comprising between 15-85% water and 85-15% soybean oil unexpectedly improves the efficiency of fungicidal substances. Various tables and results are shown in support of the above argument by comparing fungicidal

activities for emulsion based fungicidal composition and non-emulsion based fungicidal compositions.

6. First, it's noted that for some of the compositions, the activity between the emulsion based composition and the non-emulsion based composition, the degree of action is identical, for instance, the compositions comprising mancozeb, folpet, dimethomorph, azoxystrobin and fosetyl-aluminum. The only fungicidal compositions which showed any degree of difference in activity were those comprising sulphur and cyprodinil+fludioxonil. However, the difference in the activity of the compositions is minimal, and such results would not lead any person to an opinion that the emulsion based formulation resulted in improved properties over the use of the fungicidal agent itself. Second, the compositions described in the tables are not even commensurate in amount. For instances, mancozeb is used in an amount of 1470 g whereas the mancozeb when used in the emulsion is used at 490 g. It's impossible to compare the results of the tables because the amount of active agent is not similar in scope.

7. The invention does not possess unexpected results because a fungicide containing composition comprising between 15-85% water and 85-15% a vegetal oil was already known in the prior art. Although the primary reference does not teach using soybean oil as the vegetal oil, any person of ordinary skill would have been sufficiently capable of looking to the art to identify other known vegetal oils commonly used in agricultural fungicidal compositions and employ that oil in the composition of the primary reference with a reasonable expectation for success in arriving at a composition that would effectively deliver fungicides to agriculture. Thus, the selection of soybean oil is a product of ordinary skill and common sense, and its use does not lend unexpected results to the instant composition.

Response to Applicants' Arguments

8. Applicants arguments filed 04/29/2009 regarding the rejection of claims 8, 9, 22 and 23 made by the Examiner under 35 USC 103(a) over Bratescu et al. (US 6528070) in view of Narayanan et al. (US 5176736) have been fully considered but they are not found persuasive.

9. Applicants arguments filed 04/29/2009 regarding the rejection of claims 12, 16, 26 and 27 made by the Examiner under 35 USC 103(a) over Bratescu et al. (US 6528070) in view of Narayanan et al. (US 5176736) further in view of Huber-Emden et al. (US 3873703) have been fully considered but they are not found persuasive.

10. The rejection of claims 8, 9, 12, 13, 22, 23, 26 and 27 made by the examiner under 35 USC 103(a) is **MAINTAINED** for the reasons of record in the office action mailed on 02/13/2009.

11. In regards to the 103(a) rejection, Applicant asserts the following:

A) The instant composition exhibits unexpected properties which are not contained by the prior art.

12. In response to A, the Examiner respectfully disagrees. The supposed unexpected properties which Applicant claims exist in their composition and not the prior art is not found persuasive. As was noted above in the response to the declaration, the composition of the prior art teaches an emulsion comprising between 15-85% water and 85-15% vegetal oil. The oil may be that of soybean oil. Thus, if one were to endeavor to formulate a composition which possessed such ingredients, then such a composition would necessarily have the properties as currently are being claimed as unexpected. Mere recognition of latent properties in the prior art does not

render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979).

Maintained Rejections, of Record
Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 8, 9, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bratescu et al. (US 6528070; of record) in view of Narayanan et al. (US 5176736; of record).**

15. Bratescu is directed to emulsions comprising a blend of surfactants, active agents, oil and water. The emulsions may be employed in agricultural and pesticidal applications (see abstract). The emulsions is to comprise from about 3% to about 70% by weight of an oil and from about 15% to about 97% by weight of water (see column 4, lines 50-65 and claim 1; see instant claims 8, 9, 22 and 23). Exemplified oils include vegetable oils such as olive and castor oil (see column 23, lines 60-65; see instant claims 10 and 24). The emulsions composition may comprise a fungicide (see column 29, line 65).

16. Bratescu fails to teach using the emulsion specifically for agricultural cultivation. Bratescu also fails to teach the vegetable oil as being that of soybean oil as well as the emulsion improving the activity of the fungicide.

17. Narayanan is directed to delivery systems for agricultural chemicals wherein the delivery systems are emulsifiable concentrates. It is taught that the concentrates include an oily component, and an exemplified oil is soybean oil (see column 9, lines 15-20; see instant claims 8 and 9).

18. Therefore, it would have obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Bratescu and Narayanan with a reasonable expectation for success in arriving at a method of treating fungi on plants by applying a composition comprising a fungicide, between 15% and 85% water and between 85% and 15% soybean oil. Bratescu teaches such a composition and indicates that fungicides are to be included. Although Bratescu does not expressly teach using their composition on plants to prevent fungi growth on crops, Bratescu itself provides such a motivation. Bratescu states that their composition may be employed in agricultural applications, and so to a person of ordinary skill such a recitation would serve as a sufficient motivation to use their composition for the treatment of agriculture. With respect to the use of soybean as a vegetable oil in the emulsion, this is obvious. Soybean oil is a commonly used vegetable oil in agricultural emulsions, and thus one would have been motivated to implement in the composition of Bratescu with a reasonable expectation of success. With respect to improving the activity of the fungicide by use of the emulsion, this property would be present upon formulating the composition. Thus, if one were to endeavor to formulate a composition which possessed such ingredients, then such a composition would have properties which would improve the efficiency of the fungicide. Therefore, a method of treating fungi on agriculture using a composition comprising a fungicide, water and

oil is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

19. Claims 12, 13, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bratescu et al. (US 6528070; of record) in view of Narayanan et al. (US 5176736; of record) as applied to claims 8, 9, 22 and 23 above, and further in view of Huber-Emden et al. (US 3873703; of record).

20. Bratescu and Narayanan fail to teach the fungi being inhibited as being *Botrytis* spp as well as the agriculture being a tomato or potato crop.

21. Huber cures these deficiencies. Huber is directed to fungicidal compositions and methods of killing fungi with said compositions. The composition may be in the form of an emulsion (see column 3, line 25 and line 60). The composition is taught to be useful for combating fungi on grain, corn, rice, vegetable and fruit cultures (see column 3, lines 30-35). The composition is disclosed as capable of inhibiting growth of *Botrytis* and *Verticillium* (see column 3, lines 30-50; see instant claims 12 and 26).

22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Bratescu, Narayanan and Huber with a reasonable expectation for success in arriving at a method of preventing and treating the growth of fungi by administering a fungicidal emulsion wherein the fungi is a *Botrytis* and is growing on a fruit or vegetable crop. Huber teaches that fungicidal emulsions can be applied to inhibit the growth of harmful fungi such as *Botrytis* on fruit and vegetable crops. Albeit Huber doesn't specifically teach and species of vegetable of fruit crop, it would have been obvious to any

person of ordinary skill in the art to envision and apply the teachings of Bratescu and Narayanan on vegetable crops such as tomato and potato as well as on fruit crops such as peach and pear. Such a discovery that a fungicidal emulsion is useful for inhibiting growth of fungi upon such crops is not a product of innovation, but rather a product of common sense and ordinary skill in the art. Therefore, a method of inhibiting *Botrytis* and fungi growth on fruit and vegetable crops is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kyle Purdy/

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Examiner, Art Unit 1611

July 15, 2009

/David J Blanchard/

Primary Examiner, Art Unit 1643